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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,040	04/08/2004	Edouard A. Brodeur JR.	4480-64	7326

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,040

Applicant(s)

BRODEUR ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 21-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,794,009 issued to Brodeur. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims fully encompass the patented claims.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21 and 24 are rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over US 5,567,497 issued to Zegler et al.

Zegler discloses a floor covering (i.e., carpet) in tile or roll form (abstract and col. 1, lines 14-15). The carpet comprises a tufted primary carpet, a thermoplastic backing layer (i.e., pre-coat), and a thermoplastic floor-contacting layer (col. 3, lines 34-39). The contact layer is fusibly compatible with the backing layer (col. 3, lines 39-47). Both the backing layer and the contact layer may be a plasticized polyvinyl chloride (PVC) polymer or copolymer layer (col. 4, lines 1-31 and col. 5, lines 18-44). The plasticizer is present in an amount ranging from 60-120 wt. % of the PVC polymer (col. 4, lines 14-22 and col. 5, lines 34-41) and the layer may or may not contain a filler (col. 4, lines 32-34 and col. 5, lines 45-49). The surface of the contact layer has a plurality of projections extending therefrom (col. 4, lines 1-46-49) in a variety of shapes, such as semi-spherical, semi-ovoid, triangular, diamond-shaped, pentagonal, or pyramidal nodules (col. 4, lines 56-62). The contact layer may be foamed to create a lower density (i.e., cushion) than the backing layer (col. 5, lines 50-57). The contact layer may include a reinforcing scrim with thermoplastic nodules (col. 6, lines 35-36). The contact backing is bonded to the lower backing "or a thin layer of thermoplastic fused to the lower backing layer" (i.e., a fusible adhesive layer) (col. 4, lines 62-66).

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Thus, Zegler teaches the limitations of claim 21 with the exceptions (a) the open mesh fiber reinforced foam layer is “preformed,” (b) the carpet roll is “substantially void of curling,” and (c) the foam layer having nodules is bonded by adhesive to the pre-coat layer, wherein said adhesive is fused at “a temperature sufficiently low to preclude collapse of the foam nodules” or “a temperature of less than 310°F.” With respect to the first and third exceptions, the “preformed” and “temperature sufficiently low” limitations are method limitations in an article claim. As such, said limitation is not given patentable weight at this time since it has not been shown that said limitations materially effect the final product. It is the Examiner’s position that the carpet roll of Zegler is identical to or only slightly different than the presently claimed carpet roll prepared by the “preformed” and/or “temperature sufficiently low” method presently claimed, because the final products are the same (i.e., a carpet roll comprising a tufted primary backing, an adhesive precoat, and a foam layer having a scrim reinforcements and foam nodules). If the product in the product-by-process claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964. The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289.

Regarding the second exception, Zegler does not explicitly teach the limitation of curling, it is reasonable to presume that said limitation is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. tufted primary backing, an adhesive precoat, and a foam layer having a scrim reinforcements and foam nodules) used to produce the carpet roll. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ

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495. In the alternative, the claimed carpet roll being void of curling would obviously have been provided by the carpet roll disclosed by Zegler. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 21 and 24 are rejected.

6. Claim 22 and 23 are rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over US 5,567,497 issued to Zegler et al. in view of US 4,018,957 issued to Werner et al. and/or US 3,945,955 issued to Ihde, Jr.

Zegler is silent with respect to the addition of a silicon surfactant and fumed silica. However, silicon surfactants in PVC compositions are well known in the art for use in reducing the density thereof. For example, Werner and Ihde teach silicone surfactant frothing agents in PVC compositions. (See Werner, col. 4, line 26-col. 5, line 2 and Ihde, col. 4, line 50-68 and col. 5, lines 50-55.) Thus, it would have been obvious to add a silicone surfactant to the PVC composition of Zegler in order to produce a proper density.

Zegler is also silent with respect to the use of fumed silica in the PVC composition. However, fumed silica is well known in the art as an inorganic filler. Applicant is hereby given Official Notice of this fact. The Examiner notes that the facts asserted to be common and well known are capable of instant and unquestionable demonstration as being well known. To adequately traverse such a finding, Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well known in the art. Thus, it would have been obvious to one skilled in the art to choose fumed silica as a filler for the PVC composition of Zegler, since fumed silica is known in the art as a common inorganic filler.

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With respect to the limitation in claim 23 that the foam layer is devoid of blowing agent, it is argued that the final foam product is devoid of blowing agent since said agent decomposes to produce the gas which creates the foam. Therefore, claims 22 and 23 are rejected as being obvious over the cited prior art.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHERYL A. JUSKA
PRIMARY EXAMINER

cj
October 31, 2005